

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Bertil LARSSON, et al.

528 Rec'd PCT/PTO 22 MAY 2000

SERIAL NUMBER: NEW U.S. PCT APPLICATION(BASED ON PCT/SE98/02162)

F LED: HEREWITH

FOR: A METHOD OF APPLYING A TUBE MEMBER IN A STATOR SLOT IN A ROTATING ELECTRICAL MACHINE

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. §1.97

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant(s) wish to disclose the following information.

REFERENCES

■ The applicant(s) wish to make of record the references listed on the attached PTO Form 1449, as filed in "holding application" Serial No. 09/147,325 filed February 17, 1999, which contains subject matter related to that disclosed in the subject application and other bulk filing applications. Three copies of each of the listed references were provided to the Patent Office consistent with the requirements in the attached Paper No. 11 Response to Petition under 37 CFR 1.182 Seeking Special Treatment Relating to an Electronic Search Tool, and Decision on Petition under 37 CFR 1.183 Seeking Waiver of Requirements under 37 CFR 1.98.

☐ A check is attached in the amount required under 37 CFR § 1.17(p).

RELATED CASES

■ Attached is a list of applicant's pending applications or issued patents which are thought to be related to the present application.

☐ A check is attached in the amount required under 37 CFR § 1.17(p).

CERTIFICATION

The undersigned certifies that

- ☐ each item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- ☐ no item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this statement.

PETITION


☐ Applicant(s) hereby request consideration of the attached information. A check is attached in the amount of the Petition fee required under 37 CFR § 1.17(i)(1).

DEPOSIT ACCOUNT

■ Please charge any additional fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit account No. 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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INFORMATION DISCLOSURE CITATION LIST
ALTERNATE FORM PTO-1449
(Corrected Listing of Original List)

Packet Number:

9847-0001-6X PCT

Application Number 09/554884

09/147,325

Applicant(s):
MATS LEIJON ET AL

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Corrected 03/20/00

Filing Date:
FEBRUARY 17, 1999

Group Art Unit:
2834

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	1	US1304451	5/20/19	L. H. Burnham			
	2	US1418856	6/2/22	Robert B. Williamson			
	3	US1481585	1/22/24	James Robert Beard			
	4	US1728915	9/24/29	E. P. Blankenship et al			
	5	US1742985	1/7/30	L. H. Burnham			
	6	US1747507	2/18/30	Robert B. George			
	7	US1756672	4/29/30	John M. Barr			
	8	US1762775	6/10/30	Albert G. Ganz			
	9	US1781308	11/11/30	Mauritz Vos			
	10	US1861182	5/31/32	F. Hendey et al			
	11	US1974406	9/25/34	Vincent G. Apple et al			
	12	US2006170	6/25/35	Gustof A. Juhlin			
	13	US2206856	7/2/40	W. E. Shearer			
	14	US2217430	10/8/40	R. A. Baudry			
	15	US2241832	5/13/41	H.W. Wahlquist			
	16	US2251291	8/5/41	L. O. Reichelt			
	17	US2256897	9/23/41	W. F. Davidson et al			
	18	US2295415	9/8/42	G.R. Monroe			
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	20	US2424443	7/22/47	B. C. Evans			
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	23	US2459322	1/18/49	G. T. Johnston			
	24	US2462651	2/22/49	H. W. Lord			
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	29	US2885581	5/5/59	P. T. Pileggi			
	30	US2943242	6/28/60	E. Schaschl et al			
	31	US2947957	8/2/60	J. C. Spindler			
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	34	US2975309	3/14/61	M. Seidner			
	35	US3098893	7/23/63	R. A. Pringle et al			
	36	US3130335	4/21/64	L. J. Rejda			
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	41	US3304599	2/21/67	R. W/ Nordin			
	42	US3354331	11/21/67	H. L. Broeker et al			
	43	US3365657	1/23/68	James Webb			
	44	US3372283	5/5/68	A. A. Jaecklin			

Examiner

Date

Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

INFORMATION DISCLOSURE CITATION LIST
INTERNATE FORM PTO-1449
 (Corrected Listing of Original List)

09/554884

526 Rec'd PCT/PTO 22 MAY 2000

45	US3418530	11/24/68	W. H. Cheever			
46	US3435262	3/25/69	R. B. Bennett et al			
47	US3437858	4/8/69	R. B. White			
48	US3444407	5/13/69	E.S. Yates			
49	US3447002	5/27/69	C. Ronnevig			
50	US3484690	12/16/69	H. Wald			
51	US3560777	2/2/71	W. Moeller			
52	US3593123	7/13/71	A. C. Williamson			
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100	US4121148	10/17/78	H. Platzer			
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104	US4149101	4/10/79	A. Lesokhin et al			
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174	US4590416	5/20/86	M. Porche et al			
175	US4594630	6/10/86	M. Rabinowitz et al			
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177	US4615109	10/7/86	M. Wcislo et al			
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183	US4677328	6/30/87	K. Kumakura			
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186	US4723104	2/22/88	F. Rohatyn			
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197	US4860430	8/29/89	H. Raschbichler et al			
198	US4864266	9/5/89	L. Feather et al			

Examiner

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INFORMATION DISCLOSURE CITATION LIST
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 (Corrected Listing of Original List)

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526 Rec'd PCT/PTO 22 MAY 2000

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204	US4924342	5/8/90	R. Lee			
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207	US4949001	8/14/90	S. Campbell			
208	US4994952	2/19/91	D. Silva et al			
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210	US5012125	4/30/91	D. Conway			
211	US5036165	7/30/91	R. Elton et al			
212	US5036238	7/30/91	M. Tajima			
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215	US5083360	1/28/92	M. Valencic et al			
216	US5086246	2/4/92	J. Dymond et al			
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218	US5097241	3/17/92	E. Smith et al			
219	US5097591	3/24/92	M. Wcislo et al			
220	US5111095	5/5/92	J. Hendershot			
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222	US5136459	8/4/92	D. Fararooy			
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225	US5168662	12/8/92	K. Nakamura et al			
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234	US5325008	6/28/94	J. Grant			
235	US5327637	7/12/94	O. Britenbach et al			
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239	US5365132	11/15/94	J. Hann et al			
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247	US5530307	6/25/96	G. Horst			
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Examiner

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	257	US5689223	11/18/97	A Demarmels et al			
	258	US5807447	9/15/98	I. Forrest			
	259	US681800	9/3/01	O. Lasche			
Subtotal	259						

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		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	1	AT399790	7/25/95	Austria		
	2	BE565063	2/23/57	Belgium		
	3	CH391071	4/30/65	Switzerland		
	4	CH534448	2/28/73	Switzerland		
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	7	DD137164	8/15/79	Germany DDR		
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	12	DE2155371	5/17/73	Germany		
	13	DE2400698	7/10/75	Germany		
	14	DE2520511	11/18/76	Germany		
	15	DE2656389	6/15/78	Germany		
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	20	DE2835386	2/21/80	Germany		
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	25	DE2920478	12/4/80	Germany		
	26	DE2939004	4/9/81	Germany		
	27	DE3006382	8/27/81	Germany		
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	31	DE3305225	8/16/84	Germany		
	32	DE3309051	9/20/84	Germany		
	33	DE336418	6/23/20	Germany		
	34	DE3441311	5/15/86	Germany		
	35	DE3543106	6/11/87	Germany		
	36	DE3612112	10/15/87	Germany		
	37	DE372390	3/27/23	Germany		
	38	DE3726346	2/16/89	Germany		
	39	DE387973	1/9/24	Germany		

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43	DE4233558	3/31/94	Germany		
44	DE425551	2/20/26	Germany		
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47	DE433749	9/7/26	Germany		
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	41	OD042	Cloth-transformer with divided windings and tension annealed amorphous wire; T. Yamamoto et al; IEEE Translation Journal on Magnetism in Japan Vol 4, No. 9 Sept. 1989
	42	OD043	A study of equipment sizes and constraints for a unified power flow controller; J Bian et al; IEEE 1996
Subtotal	43		

GRAND TOTAL	671		
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Examiner	Date Considered
*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

Docket Number:

9847-0001-6X PCT

Application Number

09/147,325

Applicant(s):

MATS LEIJON ET AL

Filing Date:

FEBRUARY 17, 1999

Group Art Unit:

2834

526 Rec'd PCT/PTO 22 MAY 2000

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	1	US 4,292,558	9/29/1981	Carl Flick et al			
	2	US 4,656,316	4/7/1987	Hans-Juergen Meltsch			
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*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

526 Rec'd PCT/PTO 22 MAY 2000

FOREIGN PATENT DOCUMENTS						
		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	1	GB 1,319,257	6/6/1973	Anders R. Andersson et al		
	2	GB 1,322,433	7/4/1973	Siemens Akstien-gesellschaft		
	3	GB 2,070,341	9/3/1981	Hans-Georg Raschbichler et al		
	4	WO 98/20598	5/14/1998	Jan-Anders Karlfeldtsgatan et al		
	5	WO 98/20602	5/14/1998	Soren Berggren		
	6	WO 98/34239	8/6/1998	Gunnar Stenborgsgatan et al		
	7	WO 99/28922	6/10/1999	Thorsten Schutte et al		
	8	WO 99/29005	6/10/1999	Mats Leijon et al		
	9	WO 99/29023	6/10/1999	Peter Carstensen et al		
	10	WO 99/29025	6/10/1999	Mats Leijon et al		
	11	EP 0056580 A1	7/28/1982	Jacobus F.H. Van der Vegt		
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Examiner	Date Considered
*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

526 Rec'd PCT/PTO 22 MAY 2000

OTHER REFERENCES (Including Title, Author, Date, Pertinent Pages, etc.)

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GRAND TOTAL

Examiner Date
Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP0 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

LIST OF RELATED CASES

Docket No	Client Ref	Application No	Patent No	Issue Date	PCT No	Filing Date	Status
09847-0001-6X	8025	09/147,325			- PCT/SE97/008	17-Feb-99	Pending
09847-0002-6X	8026	09/147,324			PCT/SE97/008	08-Feb-99	Pending
09847-0003-6X	8030	09/147,319			PCT/SE97/009	09-Feb-99	Pending
09847-0004-6X	8031	09/147,320			PCT/SE97/009	02-Feb-99	Pending
09847-0005-6X	8039	09/147,323			PCT/SE97/008	02-Mar-99	Pending
09847-0006-6X	8086	09/147,318			PCT/SE97/009	24-Feb-99	Pending
09847-0007-6X	8088	09/147,322			PCT/SE97/009	17-Feb-99	Pending
09847-0008-6X	8163	09/147,321			PCT/SE97/009	27-Nov-98	Pending
09847-0009-6X	8090	09/297,570			PCT/SE97/018	24-Jun-99	Pending
09847-0010-6X	8099	09/297,631			PCT/SE97/018	01-Jul-99	Pending
09847-0011-6X	ENKEL 8129	09/319,923			PCT/SE97/021	17-Jun-99	Pending
09847-0012-6X	ENKEL 8379	09/319,924			PCT/SE97/021	15-Oct-99	Pending
09847-0013-6X	ENKEL 8384	09/319,925			PCT/SE97/021	14-Oct-99	Pending
09847-0014-6X	ENKEL 8247				PCT/SE97/008		Inactive
09847-0015-6X	ENKEL 8248	09/319,922			PCT/SE97/008	15-Oct-99	Pending
09847-0016-6X	ENKEL 8249	09/319,926			PCT/SE97/008	15-Oct-99	Pending
09847-0017-6X	ENKEL 8250	09/319,921			PCT/SE97/008	14-Oct-99	Pending
09847-0018-6X	ENKEL 8167	09/355,797			PCT/SE98/001	01-Nov-99	Pending
09847-0019-6X	ENKEL 8168	09/355,855			PCT/SE98/001	01-Nov-99	Pending
09847-0020-6X	ENKEL 8138	09/355,801			PCT/SE98/001	14-Oct-99	Pending
09847-0021-6X	ENKEL 8139	09/355,795			PCT/SE98/001	22-Oct-99	Pending
09847-0022-6X	ENKEL 8140	09/355,807			PCT/SE98/001	25-Oct-99	Pending

Docket No	Client Ref	Application No	Patent No	Issue Date	PCT No	Filing Date	Status
09847-0023-6X	ENKEL 8141	09/355,856			PCT/SE98/001	21-Oct-99	Pending
09847-0024-6X	ENKEL 8142	09/355,857			PCT/SE98/001	26-Oct-99	Pending
09847-0025-6X	ENKEL 8143	09/355,805			PCT/SE98/001	17-Sep-99	Pending
09847-0026-6X	ENKEL 8144	09/355,806			PCT/SE98/001	26-Oct-99	Pending
09847-0027-6X	ENKEL 8145	09/355,794			PCT/SE98/001	22-Oct-99	Pending
09847-0028-6X	ENKEL 8146	09/355,754			PCT/SE98/001	25-Oct-99	Pending
09847-0029-6X	ENKEL 8147	09/355,854			PCT/SE98/001	25-Oct-99	Pending
09847-0030-6X	ENKEL 8148	09/355,771			PCT/SE98/001	25-Oct-99	Pending
09847-0031-6X	ENKEL 8352	09/355,773			PCT/SE98/001	03-Aug-99	Pending
09847-0032-6X	ENKEL 8353	09/355,796			PCT/SE98/001	03-Aug-99	Pending
09847-0035-6X	ENKEL 8294	09/508,684			PCT/SE98/017	28-Mar-00	Pending
09847-0036-6X	ENKEL 8295	09/508,685			PCT/SE98/017	28-Mar-00	Pending
09847-0037-6X	ENKEL 8296	09/508,687			PCT/SE98/017	28-Mar-00	Pending
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09847-0041-6X	ENKEL 8300	09/508,679			PCT/SE98/017	28-Mar-00	Pending
09847-0042-6X	ENKEL 8301	09/508,681			PCT/SE98/017	28-Mar-00	Pending
09847-0043-6X	ENKEL 8302	09/508,677			PCT/SE98/017	28-Mar-00	Pending
09847-0044-6X	ENKEL 8303	09/508,683			PCT/SE98/017	28-Mar-00	Pending
09847-0045-6X	ENKEL 8304	09/508,682			PCT/SE98/017	28-Mar-00	Pending
09847-0046-6X	ENKEL 8305	09/508,689			PCT/SE98/017	28-Mar-00	Pending

Docket No.	Asea Ref.	PCT No.	U.S. No.	Date Filed
70553	8037	PCT/SE97/00874	08/973,019	11/28/97
70554	8137	PCT/SE97/00875	08/973,210	11/28/97
70555	8237	PCT/SE97/00879	08/952,993	11/28/97
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70557	8239	PCT/SE97/00884	08/973,017	11/28/97
70558	8240	PCT/SE97/00885	08/973,018	11/28/97
70559	8241	PCT/SE97/00886	08/952,996	11/28/97
70560	8242	PCT/SE97/00887	08/952,995	11/28/97
70561	8243	PCT/SE97/00888	08/973,308	11/28/97
70562	8244	PCT/SE97/00889	08/973,307	11/28/97
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70722	8342	Filed in U.S. 1st	08/980,214	11/28/97
70854	8343	Filed in U.S. 1st	08/980,213	11/28/97
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71502	8036	PCT/SE97/00905	09/194,562	11/27/98
71503	8027	PCT/SE97/00899	09/194,567	11/27/98
71504	8028	PCT/SE97/00900	09/194,564	11/27/98
71505	8034	PCT/SE97/00904	09/194,563	11/27/98
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71862	8083	PCT/SE97/01840	09/297,606	5/4/99
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71944	8353	PCT/SE98/00152		8/3/99
71945	8150	PCT/SE98/00162		8/3/99
71946	8151	PCT/SE98/00163		8/3/99
71947	8154	PCT/SE98/00164		8/3/99
71948	8155	PCT/SE98/00165		8/3/99
71949	8157	PCT/SE98/00166		8/3/99
71950	8159	PCT/SE98/00167		8/3/99
71951	8160	PCT/SE98/00168		8/3/99
71952	8161	PCT/SE98/00169		8/3/99
71953	8162	PCT/SE98/00170		8/3/99
71954	8166	PCT/SE98/00171		8/3/99
71955	8169	PCT/SE98/00174		8/3/99
71956	8170	PCT/SE98/00179		8/3/99
71957	8171	PCT/SE98/00175		8/3/99
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Oblon Spivak McClelland Maier & Neustadt
1755 Jefferson Davis Highway
Fourth Floor
Arlington VA 22202

In re Application of
Mats Leijon, et al
Application No. 09/147,325
Filed: February 17, 1999
Attorney Docket No. 9847-0001-
6X

: RESPONSE TO PETITION UNDER
: 37 CFR 1.182 SEEKING SPECIAL
: TREATMENT RELATING TO AN
: ELECTRONIC SEARCH TOOL, AND
: DECISION ON PETITION UNDER
: 37 CFR 1.183 SEEKING WAIVER
: OF REQUIREMENTS UNDER 37 CFR
: 1.98

This is a response to a September 29, 1999 Petition Under 37 CFR 1.182, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition will be treated as two separate petitions: a first petition under 37 CFR 1.182, relating to submission of an electronic search tool and the need to protect proprietary information therein, and a second petition under 37 CFR 1.183, requesting relief from the \$ 1.98 provision which requires filing paper copies of references being cited in each of many related applications.

A Decision on the petition under 37 CFR 1.182 re the electronic search tool will be issued in due course.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of IDS citations in a holding application is Granted to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Electronic Search Tool
- Part III. Petition Under 37 CFR 1.183 - Paper Copies

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OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

- Part IV. Summary
- Part V. Further Correspondence

Part 1. Background

The instant national stage application filed under 35 U.S.C. 371 currently contains claims 77-153 with three independent claims. The instant application is one of about 200 U.S. applications (either filed or to be filed) with each U.S. application having as many as 40 corresponding foreign applications (either filed or to be filed), the applications relating to different aspects of the invention. An Information Disclosure Citation List has been submitted that lists 259 U.S. patents, 369 foreign patent documents, and 43 other references for a total of 671 citations. Additionally, a list of related cases has been supplied containing 31 U.S. applications and 52 PCT applications. Paper copies have not been supplied in the related applications of any of the citations or the identified related cases.

37 CFR 1.56(b) (1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Petitioner asks "[w]hether the information cited in the manner proposed in [petition] Section 3.1.1 ... is a disclosure that is sufficient to meet the requirements of 37 CFR § 1.56." To the extent that this question refers to the content of the disclosure and the particulars of the subject applications, the Office will not answer the question. It is Office practice not to attempt to define how an individual "ensures" compliance with the rule in a particular application. See, e.g., MPEP 2004. Because determinations on this issue require an evaluation of the intent of the party involved, the Office declines to investigate the question. See MPEP 2010. To the extent that Petitioner's question concerns the form in which the disclosure is provided, rule 56 permits a disclosure in a combination of paper and electronic formats.

Petitioner, in addition to meeting the duty set forth in 37 CFR 1.56 to disclose material information, also wishes to disclose to the Office information that may not meet the definition of

materiality as set forth in the rule¹. Information identified by U.S. or foreign examiners in any of the related U.S. and foreign applications would be cited in each of the related U.S. applications.² In addition, Petitioner seeks to submit other information in each of the related U.S. applications, such as all the co-pending U.S. applications that relate to the invention (useful for determining possible double patenting rejections), and foreign search reports. Petition, page 4.

Rather than be required to submit, via a paper copy, each piece of information in each application each time the information is obtained, Petitioner seeks to have:

(1)(a) one application (the instant application) identified as a "holding" application which would contain a complete set of paper copies of references; the paper copies to be submitted in only the "holding" application;

(b) the other related pending U.S. applications, hereafter referred to as the bulk filing applications, will not contain the paper set of reference copies but will contain other information, e.g., a copy of the decision on petition³ permitting such procedure and a copy of the Form 1449 (or equivalent);⁴ and

(2) an "electronic search tool"⁵ containing different types of information.

The information supplied via the paper copies would be updated monthly, rather than as received from U.S. and foreign examiners, and cancellation of this arrangement would be an option for both

¹Reference to MPEP 2001.05, Petition, page 3.

²Petition, page 3. The present petition requesting relief does not set forth any commitment nor intent by applicant to screen such information for relevancy to each of the U.S. applications in which the information is being cited.

³The original of which would be in the instant holding application.

⁴See, Petition under 37 CFR 1.182, *infra*.

⁵See, Petition under 37 CFR 1.183, *infra*.

Petitioner and the Office upon notice. These, and other more specific conditions, are discussed in further detail in regard to the § 1.182 petition, below.

Petitioner has essentially requested relief in two areas: (1) treatment of information in an electronic search tool, to be submitted independent of any particular application, as in compliance with IDS submission requirements for all bulk filing applications, and (2) the ability to provide the paper copies of each reference in an IDS submission in only one of the bulk filing applications (the instant holding application) as well as two additional sets of copies rather than as is normally required in each application for which the reference (IDS citation) is to be considered. These two areas of relief are independent of each other and drawn toward different regulations. Accordingly, the petition has been treated as two petitions, and the present decision addresses the two areas of requested relief separately. While it is undeniable that relief in both areas would be of benefit to Petitioner, the granting of relief in one area does not, in fact, require the granting of relief in the other. Moreover, in view of the need to further consider the requested relief related to the electronic search tool, deciding the requested relief issues separately permits at this time a partial grant of the original petition.⁶

Part II. Petition under 37 CFR 1.182- Electronic Search Tool

The issues involving the electronic search tool are more extensive than those relating to the requirement for paper copies in each bulk filing application and more time is needed to fully consider and address them. Accordingly, the petition under § 1.182 shall not be decided at this time and is not treated in the instant decision on the § 1.183 petition although it will continue to be considered, with a decision rendered in due course.

⁶It is recognized that petitioner believes the issues presented by the petition may not be decided independent of one another as both the paper copy issue and the electronic search tool issue represent the most complete solution to duty of disclosure issues under 37 CFR 1.56, Petition, fn. 5.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

The submitted petition fee of \$130 will be treated as the \$ 1.183 petition fee.

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column, and page 600-103, left-hand column.

Paper copies: Petitioner notes that the instant application is one of 200 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each reference, brought to the attention of the Office in regard to any one individual application, not be required to be submitted in each such application. Rather, it is requested that three complete sets of paper copies be permitted to be filed: one set for the instant application which will be designated as a holding application; one set to be used to establish new subclasses for the technology; and one set to be used as a reference set should either or both of the other two sets become corrupted (Petition, pages 6 and 7).⁷

Once past the initial IDS submission, it is proposed that applicant would update the IDS submissions once a month, rather than every time a new reference is found, although the time frames required by § 1.97 would have to be complied with, which may mean that submissions may occur more frequently than once a month.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (Petition, page 7) and the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated. The petition is

⁷It would presumably up to the Technology Center to determine how best to store the reference set and how it is to be accessed.

silent as to whether other types of information that may be submitted in the holding application IDS, e.g., concise explanations of foreign language documents under § 1.98(a)(3), would also be supplied in all the bulk filing applications.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies), the petition states that upon allowance of the instant holding application the right is reserved to file a petition to suspend action in the instant application so that the application can remain as the holding application (Petition, page 7). Alternatively, upon agreement of the Assignee and a Director of the Technology Center involved, an alternate application may be designated as the holding application.

New subclasses: The petition envisions an affirmative duty on the Technology Center to establish new subclasses that will include each of the references submitted during the course of prosecution of the bulk filing applications.⁸ In addition, the Office is to agree that "[e]xaminers will be required to search these newly created subclasses" (from submissions by the Assignee and later by others) "as part of the routine patent prosecution process." Petition, page 8.

Termination: Petitioner seeks a right of termination,⁹ which is to be a mutual option. Termination is to be by written notice, to the attorney of record if the Office terminates and the filing of a termination request and by contacting the Director of TC 2800 if applicant terminates. Conventional IDS procedures would begin three months after notice of termination.

⁸The new subclasses will later be supplemented by references supplied by others who may file applications related to the same technology.

⁹Although termination is discussed under a section related to licensing of the electronic search tool and the petition generally (Petition, pages 10 and 11), it is presumed that Petitioner intends to have the termination provision apply to the waiver of paper copies if that alone is granted.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of references in 200 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications,¹⁰ on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.¹¹

¹⁰Even though the technology of the applications may be related, the specific claims of the applications may require different classifications of the applications and the quantity of applications would dictate the need for more than one examiner to timely examine the applications.

¹¹The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., § 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

It is noted that while the petition only refers to the submission of citations that are made by both U.S. and foreign examiners, the term "include" is used (Petition, page 2) which is open ended. The Petition states that it is the intention to submit a copy of every reference identified both by U.S. examiners in the 200 U.S. applications and by foreign examiners in as many as 40 corresponding foreign applications for each U.S. application (Petition, page 3). It has not been stated whether the current 671 reference citations currently of record represent only those citations made by U.S. and foreign examiners or whether they include citations from other sources, such as a

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing application provided that the following 8 conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- 2) The (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- 3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in the bulk filing application;
- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would

preexamination search or third party citations. See also Petition, page 19.

have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

- 7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,¹² or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
- 8) The Office has established a series of Official Digests in Class 174 based on the technology represented by the instant invention (a classification schedule thereof is attached). As is the case with all Digests, their usefulness will be continually evaluated. The Office will place the holding application's references in the Digests as they are determined to require such placement and as new ones are brought to the attention of the Office either by Petitioner or a third party. A search of the Digests themselves or what they contain (such as the holding application or reference copy sets), either in paper copy or electronic form, will be

¹²The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either the reference set of paper copies could be utilized, or the Office may decide to rely on the Digests being created.

conducted when mandatory based on the classification of the claims, or when deemed advisable - on a case by case basis.

Part IV. Summary

A Decision on the Petition under 37 CFR 1.182, drawn toward submission of the electronic search tool, will be acted upon in due course when all outstanding issues are resolved.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed,
- the required search of subclasses from one of the three sets of paper copies and placement of one of the other sets of paper copies therein, and
- any termination provision more than two months (rather than the three months that the petition sets forth) from notice of termination.

Part V. Further Correspondence

Further correspondence with respect to this matter should be addressed to Hiram H. Bernstein, Senior Legal Advisor, Special Program Law Office, as follows:

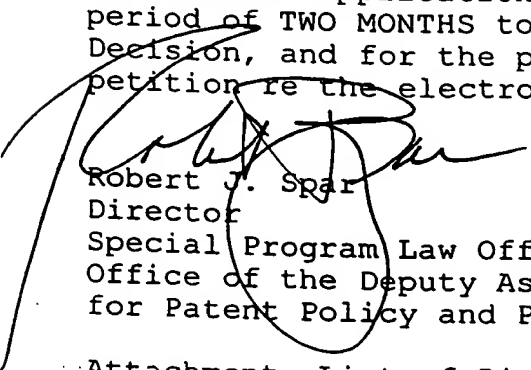
By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Special Program Law Office
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Bernstein at (703) 305-9285.

The instant application will be retained by this Office: for a period of TWO MONTHS to await any response to the instant Decision, and for the purpose of continuing review of the \$ 1.182 petition re the electronic search tool.



Robert J. Spar
Director
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Attachment: List of Digests 13-33

- Digest 13 HIGH VOLTAGE CABLE (E.G., ABOVE 10KV, CORONA PREVENTION, ETC.)
- Digest 14 . Having a particular cable application (e.g., winding, etc.)
- Digest 15 .. In a power generation system (e.g., prime-mover dynamo, generator system, etc.)
- Digest 16 .. In a motive power system (e.g., electric motor control system, etc.)
- Digest 17 .. In an electric power conversion, regulation, or protection system
- Digest 18 .. In a power distribution network
- Digest 19 .. In a dynamo-electric machine
- Digest 20 ... Stator
- Digest 21 ... Rotor
- Digest 22 ... Winding, per se
- Digest 23 .. In a circuit breaker, relay, or switch
- Digest 24 .. In an inductive device (e.g., reactor, electromagnet, etc.)
- Digest 25 ... Transformer
- Digest 26 . Having a plural-layer insulation system
- Digest 27 .. Including a semiconductive layer
- Digest 28 ... Plural semiconductive layers
- Digest 29 . Having a semiconductive layer
- Digest 30 . Having insulation with a particular dimension or geometry
- Digest 31 . Having a shield or metallic layer
- Digest 32 . Having means for cooling
- Digest 33 . Method of cable manufacture, assembly, repair, or splicing